

Remarks

This Application has been carefully reviewed in light of the Office Action mailed October 28, 2003. Applicant again respectfully submits that all pending claims are clearly allowable without amendment. Accordingly, Applicant respectfully requests reconsideration and allowance of all pending claims.

The Examiner continues to reject Claims 2-8, 10-18, and 20-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,911,776 to *Guck* in view of U.S. Patent 6,421,787 to Slaughter et al. ("*Slaughter*"). However, as clearly demonstrated in Applicant's previous Response, the proposed *Guck-Slaughter* combination fails to disclose, teach, or suggest the limitations recited in Applicant's claims. Applicant respectfully reiterates the arguments presented in Applicant's previous Response and preserves those arguments for Appeal if necessary. Applicant's previous remarks fully address the rejections set forth in Section 4 of the current Office Action and the Examiner's remarks set forth in Section 5 of the current Office Action. However, for the sake of completeness, Applicant respectfully provides the following additional remarks regarding Sections 5.a and 5.b of the current Office Action.

Office Action Section 5.a

Applicant understands that the Examiner is equating: (1) "the process of enabling an author to create and store an original document or first document or first application" with Applicant's recited first version of the single business application; and (2) "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" with Applicant's recited second version of the single business application. First, Applicant notes that the original document disclosed in *Guck* cannot properly be equated with "a first application" as the Examiner suggests in the current Office Action, much less equated with Applicant's recited first version of the single business application. Second, even if these processes could be equated with business applications, Applicant's independent Claims 6, 15, and 25 make clear that the recited first and second versions of the business application are two versions of *the same business application* rather than two completely different business applications as the Examiner's argument requires.

Applicant respectfully submits that there is no reasonable basis upon which to assert that "the process of enabling an author to create and store an original document or first document or first application," on the one hand, and "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances," on the other hand, are two versions of *the same business application*. This was made abundantly clear in Applicant's previous Response, where Applicant carried the Examiner's assertion through the entirety of Applicant's independent Claims 6, 15, and 25 and revealed the absurd result that would necessarily follow. Namely, following the Examiner's reasoning, for *Guck* to be applied against Applicant's independent Claims 6, 15, and 25, "the process of enabling an author to create and store an original document" (which the Examiner applies against Applicant's recited first version of the single business application) would need to be operable to:

- (1) determine a first version identifier for itself;
- (2) determine a second version identifier for "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Applicant's recited second version of the single business application);
- (3) exercise control over enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Applicant's recited business process) if its version is higher than the version of "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Applicant's recited second version of the single business application); and
- (4) allow "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Applicant's recited second version of the single business application) to exercise control over execution of enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Applicant's recited business process) if the version of "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Applicant's recited second version of the single business application) is higher than its version.

Since the above result, which necessarily follows from the Examiner's argument, is nonsensical, Applicant has made the only reasonable assumption available, which is that the Examiner has failed to give proper weight and meaning to the limitations specifically recited in Applicant's claims concerning the recited first and second versions of *the single business application* and the recited operations that the recited first and second versions of *the single business application* perform.

Applicant also notes that the allowability of certain dependent claims was made abundantly clear in Applicant's previous Response, where Applicant similarly carried the Examiner's assertion through the entirety of those dependent claims and revealed the absurd results that would necessarily follow.

Office Action Section 5.b

The Examiner has repeatedly acknowledged that *Guck* fails to disclose that the first version of the single business application is operable: (1) if the first version is higher than the second version, to exercise control over execution of the business process; and (2) if the second version is higher than the first version, to allow the second version of the single business application to exercise control over execution of the business process. (*See, e.g., Office Action, Page 3*) First, Applicant again notes that these elements acknowledged to be missing from the primary reference *Guck* constitute two of the three total elements in each of Applicant's independent Claims 6, 15, and 25. Second, to attempt to account for the missing elements, the Examiner: (1) equates first and second user protocols with Applicant's recited first and second versions of the single business application, respectively; (2) cites a portion of the secondary reference *Slaughter* disclosing that a protocol faster than TCP/IP may be used for data communications (*See Column 10, Lines 8-15*); and (3) asserts that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the format conversion of *Guck* by including a faster protocol as taught by *Slaughter* because such modification would provide the format conversion of *Guck* with the enhanced necessary to have a faster network communication or business process" and that "a user with a faster protocol, should have control over the business process."¹ It is very difficult if not

¹ If "common knowledge" or "well known" art is being relied on or if Official Notice is being taken, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If

impossible to understand the nature of the Examiner's proposed modification of *Guck* or how such a modification would be relevant to Applicant's claimed invention, but in any event, Applicant respectfully submits that the Examiner's conclusory assertion of obviousness is entirely insufficient under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

Applicants reiterate the remarks provided in the previous Response explaining why the Examiner's proposed combination of *Slaughter* with *Guck* is improper. Even if it would have been technologically possible to in some way combine the teachings of *Slaughter* and *Guck*, which Applicants dispute, and even if the combined teachings of *Guck* and *Slaughter* met the limitations recited in Applicants' independent claims, which Applicants also dispute as discussed above, the combination is improper under the M.P.E.P. and the governing Federal Circuit case law unless there is the required teaching, suggestion, or motivation in the prior art for the combination.

The M.P.E.P. sets forth the strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. 2143.01. The "fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.² According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson*

personal knowledge is being relied on, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

² Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).³ Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish obviousness. See *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

The Examiner's summary conclusion in Section 5.b of the Office Action that it would have been obvious to those of ordinary skill in the art at the time of Applicants' invention to include "a faster protocol as taught by Slaughter" in "the format conversion of Guck" because this "would provide the format conversion of Guck with the enhanced necessary to have a faster network communication or business process" does not even appear to be relevant to Applicant's claimed invention and is certainly not supported by any teaching, suggestion, or motivation in *Guck*, *Slaughter*, or knowledge generally available to those of ordinary skill in the art at the time of Applicants' invention. First, independent Claims 6, 15, and 25 recite that

³ See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

a first version of a business application, not "a user" as the Examiner incorrectly states, exerts or relinquishes control over execution of the business process. Second, it is entirely unclear how use of a faster protocol, such as LLCL rather than TCP/IP, relates to the limitations recited in independent Claims 6, 15, and 25. Third, if two applications are communicating in connection with a business process, the two applications would likely if not necessarily communicate with one another using the same protocol, such that allowing the application with the faster protocol to exert or relinquish control appears to make little if any sense in many, perhaps most, contexts. Fourth, it cannot be assumed that "a user with a faster protocol, should have control over the business process" and the Examiner provides no explanation as to why this should be the case. For example, it may be more desirable for the version of the business application having more, better, or newer collaboration functionality to exercise control, irrespective of the protocol it supports. Applicant respectfully submits that the Examiner's purported motivation for combining *Guck* with *Slaughter* falls well short of the requirements set forth in the M.P.E.P. and governing Federal Circuit case law. Since the Examiner has not provided a sufficient teaching, suggestion, or motivation in the prior art, the Examiner's conclusion of obviousness is improper.

Moreover, even assuming for the sake of argument that *Slaughter* was analogous art and that there was the required suggestion or motivation to combine *Guck* with *Slaughter*, which Applicant disputes as discussed above, the proposed *Guck-Slaughter* combination still would not disclose the limitations recited in Applicant's independent Claims 6, 15, and 25 for at least the reasons explained above. This is true whether the proposed *Guck-Slaughter* combination is considered alone, in combination with one or more other cited references, or in combination with information generally known to those skilled in the art at the time of the invention.

For at least these reasons, and additional reasons presented in Applicant's previous Responses, Applicant respectfully requests reconsideration and allowance of independent Claims 6, 15, and 25 and their dependent claims.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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